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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/278,601 07/21/94 KNIFE

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EXAMINER

HM21/1207

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ART UNIT

PAPER NUMBER

1643

DATE MAILED:

12/07/98

**Please find below and/or attached an Office communication concerning this application or  
proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/278,601**

Applicant(s)  
**Knipe et al**

Examiner  
**Mary Mosher**

Group Art Unit  
**1643**



☒ Responsive to communication(s) filed on 9/10/98, 9/14/98, 10/19/98, 11/16/98, 12/29/97

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-9, 12-22, 25-27, 29, and 31-49 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 1-9, 12-22, 25-27, 29, 31-45, 47, and 48 is/are allowed.

☒ Claim(s) 49 is/are rejected.

☒ Claim(s) 46 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 19,28

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1643, Examiner Mosher.

#### ***Claim Rejections - 35 USC § 112***

Claim 49 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim lacks antecedent for "the pharmaceutical composition" in parent claim 48. Is "vaccine" intended?

On reconsideration, the rejection of claims 1-3, 5-7, 9, 12-14, 16-20, 22, 25, 26, 31, 32, 33, 34, 36-39, and 41 under 35 U.S.C. 112, first paragraph, is withdrawn. The ordinary skill of the herpesvirus art is seen as sufficient to identify genes which are essential for replication in a variety of herpesviruses, and to screen for protection, using routine experimentation. Furthermore, the teachings of the specification (particularly regarding correlation of Ig subclass shift with transcription of at least some beta [early] genes, and the correlation of IFN-gamma with the subclass shift), provide some guidance for identification of viruses which effect the specific physiological responses recited in claims such as claims 1 and 5.

#### ***Claim Objections***

Claim 46 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the

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claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 45 requires the mutant herpesvirus to be replication defective. Claim 46 requires the mutation further to prevent generation of progeny virus. In the Summary of the Invention, in the passage spanning pages 2-3, applicant states that a mutation which renders the virus replication defective prevents production of progeny. Therefore claim 46 does not provide any further limitation upon the scope of claim 45.

***Claim Rejections - 35 USC § 103***

The declarations filed on September 10, 1998 under 37 CFR 1.131 are sufficient to overcome the Inglis et al reference (WO 92/05263).

***Allowable Subject Matter***

Claim 49 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action.

Claims 1-9, 12-22, <sup>25-27, 29</sup>~~25-29~~, 31-45, 47 and 48 are allowable.

***Interference***

Applicant's request for interference with patent 5,665,362 is noted. A separate communication will be issued in regard to the request. Applicant's attention is further directed to newly issued patent 5,837,261.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary E. Mosher, Ph.D. whose telephone number is (703) 308-2926. The

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examiner can normally be reached on Monday -Thursday and alternate Fridays from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909. The fax phone number for this Group is now (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196 .

December 4, 1998

*Mary Mosher*  
MARY E. MOSHER  
PRIMARY EXAMINER  
GROUP 1200  
1601